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| APPLICATION NO.                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/010,139                       | 12/05/2001  | Ah Long Wong         | 49829.00008         | 4758             |
| 30256                            | 7590        | 11/17/2005           | EXAMINER            |                  |
| SQUIRE, SANDERS & DEMPSEY L.L.P. |             |                      | VIG, NARESH         |                  |
| 600 HANSEN WAY                   |             |                      | ART UNIT            |                  |
| PALO ALTO, CA 94304-1043         |             |                      | PAPER NUMBER        |                  |

3629

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/010,139

Applicant(s)

WONG, AH LONG

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 24 drawn to client information collecting method and system for providing space in a property to tenants, gathering business information about tenants in the property; and introducing tenants to each other based on the gathered business information so that tenants may consummate business relationships classified in class 705, subclass 1.
- II. Claims 25 – 26 drawn to method and system for providing space in a property to tenants gathering business information about tenants in the property; and negotiating with vendors for tenants' needs using tenants' aggregated purchasing power classified in class 705, subclass I..

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I is directed to tenants

consummating business relationships, and, invention II is directed to negotiating with vendors for tenants' needs using tenants' aggregated purchasing power.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicant's election without traverse of Group I, claims 1 - 24 in the phone interview on 03 October 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over a Press Release "Hatching Tech Companies" by Maya Alleruzzo hereinafter known as Alleruzzo in view of an article "Bartering For Space" by Matthew Weinstock hereinafter known as Weinstock.

Regarding claims 1 and 14, in the application originally filed 05 December 2001, applicant recites "The facility service provider (FSP) leases property to tenants in exchange for money and/or equity in tenants. The FSP also runs a start-up incubator

and virtual offices in the property” [0005 – 0006]. Alleruzzo teaches system and method for providing plurality of incubator concept.

Alleruzzo does not explicitly teach providing space in a property to tenants. However, Weinstock teaches providing space in a property to tenants.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alleruzzo as taught by Weinstock to allow the tenants to use their money for R&D;

Alleruzzo in view of Weinstock teaches:  
gathering business information about tenants in the property (seeing business plan) [Alleruzzo, page 3, line 12];

introducing tenants to each other based on the gathered business information so that tenants may consummate business relationships (eIncubator serves RBS with the same modules and is introducing it to service providers like the communications company PSInet and the law firm Greenberg Traurig) [Alleruzzo, page 4].

Regarding claims 2 and 15, Alleruzzo in view of Weinstock teaches negotiating for non-exclusive business relationships with vendors to supply tenants with similar services (The entrepreneurs would receive financing and the help of a team of advisers in business planning, recruiting, accounting, legal issues and even creating a corporate identity; outsourcing of services to service providers is known to one of ordinary skill in the art at the time of invention) [Alleruzzo, page 3].

Regarding claims 3 and 16, Alleruzzo in view of Weinstock teaches negotiating for non-exclusive business relationships with vendors to supply tenants with similar products (The entrepreneurs would receive financing; outsourcing of services to service providers is known to one of ordinary skill in the art at the time of invention) [Alleruzzo, page 3].

Regarding claims 4 and 17, Alleruzzo in view of Weinstock does not explicitly teach receiving services from at least one tenant as at least a portion of consideration for providing space to the at least one tenant (bartering for space). However, It would have been obvious to one of ordinary skill in the art at the time the invention was made that providing or receiving service is of monetary value. Weinstock teaches system and method of bartering for space.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to receiving services from at least one tenant as at least a portion of consideration for providing space to reduce risk, increase tenant's stake in the business and recover cost of providing space to the tenant, allow tenant to use their money for R&D.

Regarding claims 5 and 18, Alleruzzo in view of Weinstock teaches does not explicitly teach receiving equity from at least one tenant as at least a portion of consideration for providing space to the at least one tenant. However, Weinstock teaches receiving equity from tenant as consideration for providing space.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to receiving equity from at least one tenant as at least a portion of consideration for providing space to reduce risk, increase tenant's stake in the business and recover cost of providing space to the tenant, allow tenant to use their money for R&D.

Regarding claims 6 and 19, Alleruzzo in view of Weinstock teaches business information includes tenants' needs, product offerings, and service offerings (business choice to decide what data to collect).

Regarding claims 7 and 20, Alleruzzo in view of Weinstock teaches providing an intranet portal accessible to tenants for tenants to communicate with each other (business choice to decide what services to provide to tenants; E Incubator plans to break out of physical space completely by opening an Internet-based incubator [Alleruzzo page 3]).

Regarding claims 8 and 21, Alleruzzo in view of Weinstock teaches providing a virtual mall for tenants to sell products and services both online [design choice for physical space or a portal].

Regarding claims 9 and 22, Alleruzzo in view of Weinstock does not teach providing a loyalty card program so that merchant tenants can track customer

purchases and reward customers based on amount of purchases. However, it taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to implement incentive program for motivating users to use their system. For example, airlines offering mileage for customers who sign up for services from one of the business partners of the airlines frequent flier program (e.g. credit card).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alleruzzo in view of Weinstock and provide a loyalty card program so that merchant tenants can track customer purchases and reward customers based on amount of purchases to provide motivation for users to use service or product providers affiliated with the system to minimize the loss of business to non-affiliated members.

Regarding claims 10 and 23, Alleruzzo in view of Weinstock teaches providing a start up incubator to tenants.

Regarding claims 11 and 24, Alleruzzo in view of Weinstock teaches providing at least one virtual office to at least one tenant (e.g. tenant on a portal).

Regarding claim 12, as responded to earlier in response to claim 11, Alleruzzo in view of Weinstock teaches space includes at least one virtual office.



Regarding claim 13, Allerezzo in view of Weinstock teaches space includes a physical portion of the property.

### ***Conclusion***

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig  
Examiner  
Art Unit 3629

November 14, 2005